

ADMINISTRATIVE PANEL DECISION

Philip Morris Products S.A. v. Xinke Liu

Case No. D2022-3707

1. The Parties

The Complainant is Philip Morris Products S.A., Switzerland, represented by D.M. Kisch Inc., South Africa.

The Respondent is Xinke Liu, Australia.

2. The Domain Names and Registrar

The disputed domain names <heatsmail.com>, <heatsplace.com>, <heetsplace.com>, and <heetspost.com> are registered with NameCheap, Inc. (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on October 5, 2022. On October 5, 2022, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On October 5, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Privacy service provided by Withheld for Privacy ehf) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 6, 2022, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on October 7, 2022, and on October 11, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 18, 2022. In accordance with the Rules, paragraph 5, the due date for Response was November 7, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on November 8, 2022.

The Center appointed Edoardo Fano as the sole panelist in this matter on November 11, 2022. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and

Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

The Panel has not received any requests from the Complainant or the Respondent regarding further submissions, waivers or extensions of deadlines, and the Panel has not found it necessary to request any further information from the Parties.

Having reviewed the communication records in the case file provided by the Center, the Panel finds that the Center has discharged its responsibility under the Rules, paragraph 2(a), "to employ reasonably available means calculated to achieve actual notice to the Respondent". Therefore, the Panel shall issue its Decision based upon the Complaint, the Policy, the Rules and the Supplemental Rules and without the benefit of a response from the Respondent.

The language of the proceeding is English, being the language of the Registration Agreements, as per paragraph 11(a) of the Rules.

4. Factual Background

The Complainant is Philip Morris Products S.A., a Swiss subsidiary company of Philip Morris International Inc. ("PMI"), operating as one of the international leaders in the field of tobacco and owning several trademark registrations for HEETS in relation to tobacco products to be inserted and heated in electronic cigarette devices, like PMI's IQOS branded ones.

Among the many trademark registrations for HEETS are the following ones:

- International Trademark Registration No. 1326410 for HEETS, registered on July 19, 2016.
- International Trademark Registration No. 1328679 for HEETS and design, registered on July 20, 2016.

The Complainant provided evidence in support of the above.

According to the Whois records, the disputed domain names were registered on the following dates:

<heatsmail.com> on March 1, 2022, <heatsplace.com> and <heetsplace.com> on August 16, 2022, and <heetspost.com> on August 11, 2021. The disputed domain names resolve to websites in English where allegedly the Complainant's IQOS System is offered for sale, and the Complainant's IQOS trademark and logo, as well as the Complainant's official product images and copyrighted marketing materials, are reproduced.

5. Parties' Contentions

A. Complainant

The Complainant states that the disputed domain names are confusingly similar to its trademark HEETS, as the disputed domain names <heatsplace.com> and <heetspost.com> fully incorporate the Complainant's trademark, with the addition of the descriptive words "place" and "post", while the disputed domain names <heatsmail.com> and <heatsplace.com> include a misspelled, highly similar and phonetically almost identical version of the Complainant's trademark HEETS, with the addition of the descriptive words "mail" and "place".

The Complainant asserts that the Respondent has no rights or legitimate interests in respect of the disputed domain names since it has not been authorized by the Complainant to register the disputed domain names or to use its trademark within the disputed domain names and it is not making either a *bona fide* offering of

goods or services or a legitimate noncommercial or fair use of the disputed domain names: the disputed domain names are resolving to websites in which allegedly the Complainant's IQOS System is offered for sale, and the Complainant's IQOS trademark and logo, as well as the Complainant's official product images and copyrighted marketing materials, are reproduced, suggesting an affiliation with the Complainant.

The Complainant submits that the Respondent has registered the disputed domain names in bad faith, since the Complainant's trademark HEETS is distinctive and well-known in field of tobacco and electronic devices. Therefore, the Respondent targeted the Complainant's trademark at the time of registration of the disputed domain names and the Complainant contends that the use of the disputed domain names with the purpose to attract, for commercial gain, Internet users by creating a likelihood of confusion with the Complainant's trademark as to an affiliation between the Respondent and the Complainant, qualifies as bad faith registration and use. Finally, the Complainant asserts that the purported involvement of the Respondent in the bad faith registration and use of domain names incorporating the Complainant's trademarks HEETS shows a pattern of bad faith conduct.

B. Respondent

The Respondent has made no reply to the Complainant's contentions and is in default. In reference to paragraphs 5(f) and 14 of the Rules, no exceptional circumstances explaining the default have been put forward or are apparent from the record.

A respondent is not obliged to participate in a proceeding under the Policy, but if it fails to do so, reasonable facts asserted by a complainant may be taken as true, and appropriate inferences, in accordance with paragraph 14(b) of the Rules, may be drawn (see, e.g., *Reuters Limited v. Global Net 2000, Inc.*, WIPO Case No. [D2000-0441](#); *Microsoft Corporation v. Freak Films Oy*, WIPO Case No. [D2003-0109](#); *SSL International PLC v. Mark Freeman*, WIPO Case No. [D2000-1080](#); *Altavista Company v. Grandtotal Finances Limited et. al.*, WIPO Case No. [D2000-0848](#); *Confédération Nationale du Crédit Mutuel, Caisse Fédérale du Crédit Mutuel Nord Europe v. Marketing Total S.A.*, WIPO Case No. [D2007-0288](#)).

6. Discussion and Findings

Paragraph 4(a) of the Policy lists three elements, which the Complainant must satisfy in order to succeed:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

A. Identical or Confusingly Similar

The Panel finds that the Complainant is the owner of the trademark HEETS both by registration and acquired reputation and that the disputed domain names are confusingly similar to the trademark HEETS.

Regarding the use of the term "heats" to replace the term "heets" of the Complainant's trademark in the disputed domain names <heatsmail.com> and <heatsplace.com>, the Panel notes that this is a typical case of a deliberate misspelling of a mark (so-called "typosquatting"), by adding, deleting, substituting or reversing the order of letters in a mark, where numerous UDRP panels in the past have found confusing similarity to be present, see, *inter alia*, *Yurtici Kargo Servisi A.S. v. Yurticikargo Yurticikargo*, WIPO Case No. [D2003-0707](#); *CareerBuilder, LLC v. Azra Khan*, WIPO Case No. [D2003-0493](#); *The Sportsman's Guide, Inc. v. Vipercom*, WIPO Case No. [D2003-0145](#); *Neuberger Berman Inc. v. Alfred Jacobsen*, WIPO Case No. [D2000-0323](#). The use of the term "heats" to replace the term "heets" does not therefore prevent the disputed domain names <heatsmail.com> and <heatsplace.com> from being confusingly similar to the Complainant's

trademark and can be considered as a case of typosquatting. See [WIPO Overview 3.0](#), section 1.9.

Regarding the addition of the terms “place”, “post” and “mail”, the Panel notes that it is now well established that the addition of descriptive or geographical terms or letters to a domain name does not prevent a finding of confusing similarity between the disputed domain name and the trademark (see, e.g., *Aventis Pharma SA., Aventis Pharma Deutschland GmbH v. Jonathan Valicenti*, WIPO Case No. [D2005-0037](#); *Red Bull GmbH v. Chai Larbthanasub*, WIPO Case No. [D2003-0709](#); *America Online, Inc. v. Dolphin@Heart*, WIPO Case No. [D2000-0713](#)). The addition of the terms “place”, “post” and “mail” does not therefore prevent the disputed domain names from being confusingly similar to the Complainant’s trademark. See WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition (“[WIPO Overview 3.0](#)”), section 1.8.

It is also well accepted that a generic Top-Level Domain (“gTLD”), in this case “.com”, is typically ignored when assessing the confusing similarity between a trademark and a domain name. See [WIPO Overview 3.0](#), section 1.11.

The Panel finds that the Complainant has therefore met its burden of proving that the disputed domain names are confusingly similar to the Complainant’s trademark, pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Respondent has failed to file a response in accordance with the Rules, paragraph 5.

The Complainant in its Complaint, and as set out above, has established a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names. It asserts that the Respondent, who is not currently associated with the Complainant in any way, is not using the disputed domain names for a legitimate noncommercial or fair use or in connection with a *bona fide* offering of goods or services, but instead on the websites at the disputed domain names the Complainant’s trademark IQOS and logo, as well as copyright-protected materials, are reproduced, and allegedly the Complainant’s IQOS System is offered for sale.

The *prima facie* case presented by the Complainant is enough to shift the burden of production to the Respondent to demonstrate that it has rights or legitimate interests in the disputed domain names. However, the Respondent has not presented any evidence of any rights or legitimate interests it may have in the disputed domain names.

Should the Complainant’s products sold on the websites to which the disputed domain names are directing Internet users be genuine products, legitimately acquired by the Respondent, the question that would arise is whether the Respondent would therefore have a legitimate interest in using the disputed domain names that are confusingly similar to the Complainant’s trademark in circumstances that are likely to give rise to confusion.

According to the current state of UDRP decisions in relation to the issue of resellers as summarized in the [WIPO Overview 3.0](#), section 2.8.1:

“[...] resellers, distributors, or service providers using a domain name containing the complainant’s trademark to undertake sales or repairs related to the complainant’s goods or services may be making a *bona fide* offering of goods and services and thus have a legitimate interest in such domain name. Outlined in the ‘Oki Data test’, the following cumulative requirements will be applied in the specific conditions of a UDRP case:

- (i) the respondent must actually be offering the goods or services at issue;
- (ii) the respondent must use the site to sell only the trademarked goods or services;
- (iii) the site must accurately and prominently disclose the registrant’s relationship with the trademark holder; and

(iv) the respondent must not try to ‘corner the market’ in domain names that reflect the trademark.”

This summary is based on the UDRP decision in *Oki Data Americas, Inc. v. ASD, Inc.*, WIPO Case No. [D2001-0903](#).

While it is unclear to the Panel whether the products offered on the website are genuine, the Panel finds that the disclaimer is not presented in a sufficient and prominent manner. Instead, the Respondent uses the Complainant’s IQOS trademark and logo, as well as the Complainant’s official advertising material, in a likely attempt of creating a likelihood of confusion that is not sufficiently discharged by the added disclaimer.

In addition, the Panel notes that the Respondent has registered four disputed domain names in a likely attempt of trying to “corner the market”, and that the website at the disputed domain names shows links to third party competing products such as RELX, and YOOZ.

The Panel therefore concludes that the disputed domain names are not being used in connection with a *bona fide* offering of goods or services.

Moreover, the Panel finds that the composition of the disputed domain names along with their use carries a risk of implied affiliation. See [WIPO Overview 3.0](#), section 2.5.1.

The Panel therefore finds that paragraph 4(a)(ii) of the Policy has been satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy provides that “for the purposes of paragraph 4(a)(iii) of the Policy, the following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith:

(i) circumstances indicating that [the respondent has] registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the complainant who is the owner of the trademark or service mark or to a competitor of the complainant, for valuable consideration in excess of its documented out-of-pocket costs directly related to the domain name; or

(ii) that [the respondent has] registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that [the respondent has] engaged in a pattern of such conduct; or

(iii) that [the respondent has] registered the domain name primarily for the purpose of disrupting the business of a competitor; or

(iv) that by using the domain name, [the respondent has] intentionally attempted to attract, for commercial gain, Internet users to [the respondent’s] website or other online location, by creating a likelihood of confusion with the complainant’s mark as to the source, sponsorship, affiliation, or endorsement of [the respondent’s] website or location or of a product or service on [the respondent’s] website or location”.

Regarding the registration in bad faith of the disputed domain names, the reputation of the Complainant’s trademark HEETS in the tobacco and electronic devices field is clearly established and the Panel finds that the Respondent obviously knew of the Complainant and deliberately registered the disputed domain names, especially because the websites at the disputed domain names are reproducing the IQOS trademark and logo of the Complainant and are offering for sale the same products as the Complainant, namely electric tobacco heating devices and relevant sticks.

The Panel further notes that the disputed domain names are also used in bad faith since on the relevant websites the Complainant’s IQOS trademark and logo are displayed in an attempt to pass off as an online retailer of the Complainant, while also including links to third party competing products.

The above suggests to the Panel that the Respondent intentionally registered and is using the disputed domain names in order to create confusion with the Complainant's trademark and attract, for commercial gain, Internet users to its websites in accordance with paragraph 4(b)(iv) of the Policy.

The Panel therefore finds that paragraph 4(a)(iii) of the Policy has been satisfied.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain names <heatsmail.com>, <heatsplace.com>, <heetsplace.com>, and <heetspost.com>, be transferred to the Complainant.

/Edoardo Fano/

Edoardo Fano

Sole Panelist

Date: November 23, 2022